

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN R. SMITH

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Appeal 97-1499  
Application 08/242,297<sup>1</sup>

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ON BRIEF

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Before: McKELVEY, Senior Administrative Patent Judge, and  
SCHAFFER and LEE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

Upon consideration of the NEW, COMPLETE BRIEF ON APPEAL  
(Paper 14), the EXAMINER'S ANSWER (Paper 15 mailed 12 February

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<sup>1</sup> Application for patent filed 13 May 1994. The real party in interest is Decora, Incorporated.

Appeal No. 97-1499  
Application 08/242,297

1996), the REPLY BRIEF (Paper 16) and the supplemental  
EXAMINER'S ANSWER (Paper 17 mailed 2 August 1996), it is

ORDERED that the decision of the examiner rejecting  
claims 19-22, 24 and 26-27 as being unpatentable under  
35 U.S.C. § 103 over Sackoff, U.S. Patent 4,151,319 (1979), is  
reversed.

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We understand the examiner to have determined that claim  
19 did not call for adhesive layer **20**. In our opinion, the  
examiner failed to accord sufficient and appropriate weight to  
the limitation "adhered to" in paragraph (a)(ii) of claim 19.  
A review of Fig. 4 of the drawing and the corresponding  
description of Fig. 4 in the specification will reveal that  
Fig. 4 describes a laminate with "a substrate layer" **22** and a  
"first stabilizing layer" **10** "adhered" together with an  
adhesive layer **20**. See also page 4, line 1 of the  
specification.

The language "adhered to" is found in claim 19 and must  
be given appropriate weight. To determine the meaning of  
"adhered to" we have looked to the specification. Compare  
Digital Biometrics Inc. v. Identix Inc., 149 F.3d 1335, 1344,

47 USPQ2d 1418, 1424 (Fed. Cir. 1998). Paraphrasing Judge Plager's opinion for the court the following becomes apparent. To determine the proper meaning of claims, one first considers the so-called intrinsic evidence, i.e., the claims, the written description, and, if in evidence, the prosecution history.<sup>2</sup> Within the intrinsic evidence, however, there is a hierarchy of analytical tools. The actual words of the claims are the controlling focus. The written description is considered, in particular to determine if the patentee acted as its own lexicographer, and ascribed a certain meaning to terms in the claims. If not, the ordinary meaning as understood by one having ordinary skill in the art controls. See also Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1309, 51 USPQ2d 1161, 1169 (Fed. Cir. 1999) (to ascertain the meaning of claims, we consider three sources: the claims, the written description, and the prosecution history).

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<sup>2</sup> We do not find it necessary to rely on the prosecution history given the clear description in the specification of the need for an adhesive layer between the substrate layer and the first stabilizing layer. Nevertheless, the prosecution history in the form of page 4, first full paragraph, of the NEW, COMPLETE BRIEF ON APPEAL, reveals that applicant regards his claimed invention to require the presence of an adhesive layer between the substrate layer and the first stabilizing layer.

In a light most favorable to the examiner's position, Sackoff describes a laminate (Fig. 6) containing a substrate layer **106**, an adhesive layer **104** and a release layer **100**.<sup>3</sup> Sackoff also describes a possibility that substrate layer **106** can be composed of two or more separate sub-layers (col. 8, line 5), including layers of polyvinyl chloride (col. 7, line 67), polyolefins (col. 7, last line) and polyesters (col. 8, line 1). Sackoff does not say that the two or more sub-layers are "adhered" one to the other or, if they are adhered, how. We decline to speculate on the various possible manners in which the layers might be adhered. Compare In re Hughes, 345 F.2d 184, 145 USPQ 467 (CCPA 1965) (if a reference is subject to two or more interpretations or possibilities, then it is ambiguous).

**REVERSED.**

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<sup>3</sup> We note that the adhesive layer and the release layer are on the same side of the substrate, whereas claim 19 seems to require that the adhesive layer be on one side of the substrate and the release layer on the other side. Thus, there is a difference between the order of the layers in Sackoff Fig. 6 and the subject matter of claim 19. Applicant has not based the appeal on the difference. Hence, we have not taken the difference into account in deciding the appeal. 37 CFR § 1.192(a).

Appeal No. 97-1499  
Application 08/242,297

PATENT

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FRED E. McKELVEY, Senior )  
Administrative Patent Judge )  
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RICHARD E. SCHAFER ) BOARD OF  
Administrative Patent Judge ) APPEALS AND  
 ) INTERFERENCES  
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JAMESON LEE )  
Administrative Patent Judge )

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